



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hohn et al.
Serial No. : 10/616,783
Filed : July 10, 2003
Title : WAVELENGTH-CONVERTING CASTING COMPOSITION AND LIGHT-
EMITTING SEMICONDUCTOR COMPONENT

Art Unit : 2826
Examiner : Minh Loan Tran

MAIL STOP RCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Applicants request consideration of the information below and the references listed on the attached PTO-1449 form. Under 37 C.F.R. § 1.98 (a)(2)(ii), only copies of foreign patent documents and/or non-patent literature are enclosed. Copies of any listed U.S. patents or U.S. patent application publications can be provided upon request. Also disclosed as part of this Information Disclosure Statement (IDS) are copies of communications from foreign patent offices regarding foreign counter-part applications.

U.S. Patent Nos. 6,066,861 ("the '861 patent"), 6,245,259 ("the '259 patent"), 6,277,301 ("the '301 patent"), 6,592,780 ("the '780 patent"), and 6,613,247 ("the '247 patent"), which are related to the present application and will be collectively referred to hereinafter as "the particle-size patents," are part of the following litigation in the United States District Court for the District of Columbia, specifically:

CITIZEN ELECTRONICS COMPANY, Ltd. vs. OSRAM GMBH and OSRAM
OPTO SEMICONDUCTORS GMBH – Case Number 1:05CV01560

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

10-17-05
Date of Deposit
Signature *Cheryl A. Cason*
CHERYL A. CASON
Typed or Printed Name of Person Signing Certificate

In its complaint (a copy of which is enclosed), Citizen alleges that the particle size patent are invalid. Citizen has not yet presented any evidence in the litigation in support of this allegation. This case was originally filed in the United States District Court for the District of Columbia as Case Number 1:05CV00112 (a copy of the complaint is enclosed); however, this earlier cases was dismissed.

The particle-size patents, which as noted above are related to the present application, are also part of a litigation before the United States International Trade Commission ("ITC"), specifically:

In the Matter of: CERTAIN LIGHT-EMITTING DIODES AND PRODUCTS
CONTAINING SAME – Investigation No. 337-TA-512

With regard to the ITC litigation, we submit a copy of the public version of the "Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond," a copy of the "Notice of Commission Final Determination of No Violation of Section 337 as to One Patent and Determination to Remand the Investigation as Certain Other Patents," and a copy of the public version of the "Commission Opinion."

During the ITC litigation, it was alleged, unsuccessfully, that: 1) the particle-size patents are invalid as indefinite because they fail to specify whether "mean grain diameter d_{50} " refers to a mean or a median, since d_{50} typically refers to a median; 2) the particle-size patents are invalid as indefinite because they fail to specify whether "mean grain diameter d_{50} " should be calculated by number, volume, length, or area; 3) the particle-size patents are invalid as indefinite because they fail to specify the instrument and/or methodology that should be used to measure "mean grain diameter d_{50} " of the phosphor particles; 4) the particle-size patents are invalid as indefinite because they fail to specify whether the grain diameter in "mean grain diameter d_{50} " is the volume spherical equivalent diameter, the projected area spherical equivalent diameter, or the Feret spherical equivalent diameter; 5) the asserted claims of the particle-size patents are obvious in view of U.S. Patent No. 5,998,925 ("Shimizu") in combination with the Phosphor Handbook by Shionoya and Yen; 6) the asserted claims are obvious in view of JP 04-137570 in

combination with the Phosphor Handbook; and 7) the asserted claims of the particle-size patents are obvious in view of JP 05-152609 in combination with the Phosphor Handbook.

The accused infringer did not pursue the obviousness allegations at trial, so the Court did not address these allegations further (see, page 56 from the Initial Determination.) With respect to the indefiniteness allegations, the administrative judge initially found the particle-size patents invalid because the words “mean” and “ d_{50} ” in the claim expression “mean grain diameter d_{50} ” were allegedly incompatible (see, for example, pages 29-40 and 56-57 from the Initial Determination). However, the ITC Commission later overruled this conclusion and found all claims valid (see pages 4-14 of the Commission Opinion). Additional documents further describing the invalidity allegations exist, however, they are filed with the ITC under seal.

In its Opinion, the ITC Commission also addressed claim construction, concluding that “mean grain diameter d_{50} ” should be calculated based on a volume-distribution for the particles (see pages 4-14 of the Commission Opinion.) For at least the reasons summarized in the Commission Opinion, applicants disagree with this construction and submit that “mean grain diameter d_{50} ” simply refers to the median particle diameter based on a number-distribution (i.e., half of the particles have a diameter greater than or equal to this diameter and the other half of the particles have a diameter less than or equal to this number.)

As noted above, the present application is related to the particle-size patents. Specifically, the present application claims priority to the application that issued as the ‘780 patent, which in turn claims priority to the application that issued as the ‘259 patent, which in turn claims priority to the application that issued as the ‘301 patent, which in turn claims priority to the application that issued as the ‘861 patent. Similarly, the ‘247 patent claims priority to the application that issued as the ‘301 patent. In addition, U.S. Patent Application Serial No. 10/623,819 was filed July 21, 2003 claiming priority to the application that issued as the ‘247 patent, and U.S. Patent Application Serial No. 09/731,406 filed December 6, 2000 claiming priority to the application that issued as the ‘301 patent. We note that in one or more of these applications, an Examiner may have taken a position different from that of the present Examiner. For example, in Serial No. 09/731,406 claims amended to remove a limitation to “epoxy” were rejected as allegedly failing to meet the written description requirement. We presume the present

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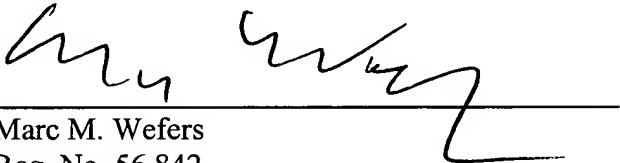
Attorney's Docket No.: 12406-006003 / 1997P2507 US
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Examiner has access to the file histories for these related applications should he wish to investigate such allegations further.

This filing is being made with the filing of a Request for Continued Examination. No fee is required.

Respectfully submitted,

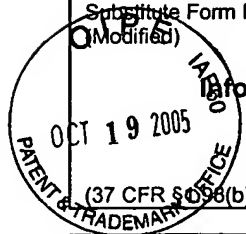
Date: 10/17/05



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Substitute Form PTO-1449 (Modified)  Information Disclosure Statement by Applicant (Use several sheets if necessary) (37 CFR § 1.98(b))	U.S. Department of Commerce Patent and Trademark Office	Attorney's Docket No. 12406-006003	Application No. 10/616,783
	Applicant Hohn et al.		
	Filing Date July 10, 2003	Group Art Unit 2826	

U.S. Patent Documents

Examiner Initial	Desig. ID	Document Number	Publication Date	Patentee	Class	Subclass	Filing Date If Appropriate
	AA	2,096,693	10/1937	Cox			
	AB	2,192,869	03/1940	Pearce			
	AC	3,602,758	08/1972	Thorton			
	AD	3,742,833	07/03/1997	Sewell et al.			
	AE	3,976,877	08/1976	Thillays			
	AF	4,203,792	05/1980	Thompson			
	AG	4,307,297	12/1981	Groff et al.			
	AH	4,758,449	07/19/1988	Kimura et al.			
	AI	4,843,280	06/1989	Lumbard et al.			
	AJ	4,851,695	07/1989	Stein			
	AK	4,875,750	10/1989	Spaeth et al.			
	AL	4,935,856	06/1990	Dragoon			
	AM	5,035,483	07/30/1991	Waitl et al.			
	AN	5,166,456	11/24/1992	Yoshino			
	AO	5,294,897	03/15/1994	Notani et al.			
	AP	5,382,452	01/17/1995	Bruno et al.			
	AQ	5,387,836	02/07/1995	Adachi et al.			
	AR	5,479,050	12/26/1995	Pritchard et al.			
	AS	5,543,657	08/06/1996	Diffenderfer et al.			
	AT	5,545,386	08/13/1996	Kaneyoshi et al.			
	AU	5,685,071	11/1997	Gates, Jr. et al.			
	AV	5,863,810	01/1999	Kaldenberg			
	AW	5,879,647	03/09/1999	Wataya et al.			
	AX	6,066,861	05/23/2000	Höhn et al.			
	AY	6,085,971	07/11/2000	Tews et al.			
	AZ	6,140,040	10/31/2000	Palm et al.			
	AAA	6,180,029	01/2001	Hampden-Smith et al.			

Examiner Signature	Date Considered
EXAMINER: Initials citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

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U.S. Patent Documents							
Examiner Initial	Desig. ID	Document Number	Publication Date	Patentee	Class	Subclass	Filing Date If Appropriate
	BA	6,245,259	06/12/2001	Höhn et al.			
	BB	6,277,301	08/21/2001	Höhn et al.			
	BC	6,295,750	10/2/2001	Harwell et al.			
	BD	6,455,213	09/24/2002	Lee			
	BE	6,592,780	07/15/2003	Höhn et al.			
	BF	6,596,141	07/22/2003	Rasmussen			
	BG	6,613,247	09/02/2003	Höhn et al.			
	BH	6,666,993	12/23/2003	Milewski			
	BI	6,692,659	02/17/2004	Brown et al.			
	BJ	RE 34,254	05/18/1993	Dragoon			
	BK	2001/0045647	11/29/2001	Höhn et al.			
	BL	2004/0016908	01/29/2004	Höhn et al.			

Foreign Patent Documents or Published Foreign Patent Applications								
Examiner Initial	Desig. ID	Document Number	Publication Date	Country or Patent Office	Class	Subclass	Translation	
							Yes	No
	BM	1 007 825	10/31/1995	Belgium	E01F	G02B	Abstract Only	
	BN	0 387 715	09/19/1990	EPO	H05B	33/14		
	BO	1915290	10/02/1969	Germany			Abstract Only	
	BP	DE 7128442	12/30/1971	Germany			X	
	BQ	297 24 381	12/03/2001	Germany			X	
	BR	2149416	06/12/1985	Great Britain			Abstract Only	
	BS	06 104491	04/15/1994	Japan	H01L	33/00	Abstract Only	
	BT	08-032120	02/02/1996	Japan	H01L	33/00	Abstract Only	
	BU	09 027642	01/28/1997	Japan	H01L	33/00	Abstract Only	
	BV	10-242513	09/11/1998	Japan			Abstract Only	

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	Applicant Hohn et al.		
	Filing Date July 10, 2003	Group Art Unit 2826	

Foreign Patent Documents or Published Foreign Patent Applications

Examiner Initial	Desig. ID	Document Number	Publication Date	Country or Patent Office	Class	Subclass	Translation	
							Yes	No
	CA	10 012925	01/16/1998	Japan	H01L	33/00	Abstract Only	
	CB	51145288	12/14/1976	Japan			Abstract Only	
	CC	53001180	01/07/1978	Japan			Abstract Only	
	CD	53-100787	09/02/1978	Japan	H01L	33/00	Abstract Only	
	CE	54-066093	05/28/1979	Japan	H01L	33/00	Abstract Only	
	CF	58-043584	03/14/1983	Japan	H01L	33/00	Abstract Only	
	CG	61-240680	10/25/1986	Japan			Abstract Only	
	CH	61-248839	11/06/1986	Japan			Abstract Only	
	CI	96/23030	08/01/1996	WIPO				
	CJ	97/48138	12/18/1997	WIPO				
	CK							
	CL							

Other Documents (include Author, Title, Date, and Place of Publication)

Examiner Initial	Desig. ID	Document
	CM	Möllmer et al., "Siemens SMT TOP-LED for Surface Mounting", <u>Siemens Components</u> , Bd. 26, No. 6, pp. 193-196 (1991)
	CN	Translation of Japanese Office Action Dated June 2, 2005
	CO	Notice of European Opposition Dated September 15, 2003
	CP	Notice of European Opposition Dated February 28, 2005
	CQ	Six European Search Reports dated May 25, 2005
	CR	<i>In the Matter of Certain Light-Emitting Diodes and Products Containing Same</i> , Investigation No. 337-TA-512, "Notice of Commission Final Determination of No Violation of Section 337 as to One Patent and Determination to Remand the Investigation as Certain Other Patents," Dated August 10, 2005
	CS	<i>In the Matter of Certain Light-Emitting Diodes and Products Containing Same</i> , Investigation No. 337-TA-512, "Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond," (Public Version), Dated May 10, 2005

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		Applicant Hohn et al.	
		Filing Date July 10, 2003	Group Art Unit 2826

Other Documents (include Author, Title, Date, and Place of Publication)

Examiner Initial	Desig. ID	Document
	DA	<i>In the Matter of Certain Light-Emitting Diodes and Products Containing Same</i> , Investigation No. 337-TA-512, "Commission Opinion," (Public Version), Dated August 29, 2005
	DB	Summons and Complaint re: Citizen Electronics Company, Ltd. v. Osram GmbH and Osram Opto Semiconductors GmbH, Case Number 1:05CV01560
	DC	Summons and Complaint re: Citizen Electronics Company, Ltd. v. Osram GmbH and Osram Opto Semiconductors GmbH, Case Number 1:05CV00112
	DD	Office Action from the Korean Patent Office dated August 25, 2005
	DE	A.S. Murphy et al., "Breaking the Boundaries of Jameson Cell Capacity" http://www.xstratatech.com/doc/jc_boundaries_en.pdf
	DF	Clive Washington, <i>Particle Size Analysis in Pharmaceuticals and Other Industries Theory and Practice</i> , Ellis Horwood Limited, (1992), pp. 18-23
	DG	"Phosphor L175" <i>Phosphors</i> (6/1997)
	DH	"Lamp Phosphor Data Sheet", from Nichia Kagaku Kogyo K.K., (May 16, 1995)
	DI	"Representation of results of particle size analysis – Part 2: Calculation of average particle sizes/diameters and moments from particle size distributions", <i>International Standard, ISO 9276-2</i> , pp. 1-12 (2001)
	DJ	Robert H. Perry, Don W. Green, and James O. Maloney (eds.), <i>Perry's Chemical Engineers' Handbook Seventh Edition</i> , McGraw Hill (1997), pp. 20-5 – 20-6
	DK	Shigeo Shionoya and William M. Yen (eds.), <i>Phosphor Handbook</i> , CRC Press, pp. 495-498 (1999)
	DL	Shigeo Shionoya and William M. Yen (eds.), <i>Phosphor Handbook</i> , CRC Press, pp. 733-776 (1999)
	DM	
	DN	

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